

REMARKS**I. INTRODUCTION AND OVERVIEW**

Applicants respectfully request reconsideration of the statement in the October 27, 2008 Office Action that the reissue declaration filed with this application is defective. Applicants filed an original declaration with this reissue application, and two supplemental declarations on May 8, 2007 and July 31, 2007, respectively. In combination, the original declaration and the supplemental declarations are presented as meeting all the requirements of the patent statute, the PTO Rules of Practice, 37 CFR, and the MPEP.

The October 27, 2008 Office Action states a requirement that “the specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims.”¹ This statement is understood to mean that the Office requiring that all specific changes and amendments to the claims must be identified in detail in the declaration. This statement is also understood to mean that the Office is stating that identification of an error in the original claims in the declaration is not enough.

Respectfully, this requirement for identification of all specific changes/amendments to the claims in the declaration is not supported in the patent statute, CFR or MPEP. Therefore, the requirement stated in the Office Action as to the oath/declaration should be withdrawn.

Applicants have diligently studied all three of the patent statute, CFR and MPEP and cannot locate support for the Office Action requirement. The requirement appears to be a “vestige” or “leftover” of reissue oath/declaration practice before December 1, 1997. On that date, the CFR moved from an “all errors/changes” approach as to reissue oaths/declarations to a “one error” approach as to such oaths/declarations, as will be explained.

¹ The brackets in this quotation, that is, the symbol “[],” indicate the deletion of the word “also.” The full sentence from which the quotation is taken is this: “The specific changes/amendments to the claims must also be identified in detail in the declaration, in addition to the errors in the original claims.”

Routine PTO practice also does not support the requirement. Applicants have canvassed recent reissue patents from the recent RE 40,666 back thirty patents, through the also recent RE 40,636, as will be presented below. These patents were reissued without meeting a requirement as stated in the Office Action. Applicants' original declaration and supplemental declarations satisfy the patent statute, CFR and MPEP. Indeed, they are as satisfactory as the relevant declarations in the thirty reissue patents the Office has reissued and the applicant has studied.

Nonetheless, in order to advance the prosecution of this application, Applicants submit herewith a third Supplemental Declaration, attached as Exhibit A (the declaration of Exhibit A is two duplicate originals of the one declaration, signed by the two living inventors of this case, on their behalf and behalf of the deceased, third inventor; for explanation, see below). This third Supplemental Declaration identifies the specific changes/amendments to the claims that were made to overcome applicants' error in claiming less than they had a right to claim. It therefore meets the requirement of the October 27, 2008 Office Action, even though that requirement is asserted to be error.

This reissue application is ten years old. The patent has a remaining possible life of about 6-1/2 years. One of the three inventors is now deceased, having died in 2003. Meanwhile, all requirements for reissue have been met, save the single requirement made in the Office Action as to the oath/declaration. There is no outstanding matter of the prior art, recapture or another matter. Those matters have been considered and resolved.

The time has come for this reissue application to issue as a patent. Reconsideration and withdrawal of the objection to the reissue declaration is respectfully requested.

II. REVIEW OF THE PROSECUTION HISTORY AS TO REISSUE OATHS/DECLARATIONS**A. THE ORIGINAL DECLARATION**

Attention is first directed to the original reissue declaration filed with this application. A copy is attached to this paper as Exhibit B. (Applicants note that two inventors signed on one original of the declaration, and a third inventor signed a duplicate original). After statements of other matters, at paragraph 5, the declaration stated that the patent of this application was believed to be partially inoperative by reason of claiming less than the applicants had a right to claim. Specific errors were identified. For example, in paragraph 7, claims 1 and 51 were stated to be directed to a wear assembly which includes, *inter alia*, a rigid lock. The recitation that the lock had a rigid construction was stated to be more narrow than the applicants had a right to claim.

B. THE CHANGES/AMENDMENTS MADE TO THE CLAIMS

Applicants note that they asserted that claims 1 and 51 included the error of being too narrow by unnecessarily stating that a lock was rigid. Applicants did not, however, amend claim 1, claim 51, or any original claims. Instead, as they were also able to do appropriately, to overcome errors, applicants included additional claims in the reissue application. An example of what applicants intended the additional claims to accomplish is illustrated by a comparison of additional claim 55 with original claim 1. See Exhibit C attached, with a first page from the reissue application that shows original claim 1 and a second page from the reissue application that shows additional claim 55. As can be seen, applicants included additional claim 55, in part, to overcome the error of claim 1 as to rigidity of the lock. That is, additional claim 55 does not recite that the lock is rigid. Claim 1 recites “a rigid lock ...” at line 27, and claim 55 recites “a lock,” deleting the word “rigid,” at its line 9.

C. PROSECUTION THEREAFTER

In a first Office Action, Paper 11, many claims were allowed, while other claims were the subject of objections, and rejections under (a) 35 USC 112, (b) recapture law, (c) 35 USC 102, and (d) 35 USC 103. However, there was no statement that the original declaration was defective, and that was a correct absence of statement. The original declaration was not defective.

After claims were amended, and arguments made, the next Office Action, paper 14, narrowed the objections and rejections to only two claims, and only as to a matter of 35 USC 102. Again, there was no statement that the original declaration was defective, and that was a correct absence of statement. The original declaration was not defective.

In the next Amendment, applicants added additional claims 74-114. A request for continued examination was filed. A preliminary amendment followed. Claims 115-118 were added. After this, the next Office Action mailed November 21, 2001 included objections and rejections directed to the new claims as to recapture, new matter, and 35 USC 102.

After another amendment, an Office Action, paper 22, continued the rejections as to recapture and 35 USC 102.

D. THE REQUIREMENT FOR A SUPPLEMENTAL OATH/DECLARATION

After another amendment, supplemental amendment and RCE, an Office Action mailed November 17, 2003 required a supplemental declaration. See Exhibit D. The Office Action first made the requirement that specific changes and amendments to the claims must be identified in detail in the declaration. The Office Action also rejected claims 119-139 under 35 USC 103.

The requirement is understood to have continued, however, to expressly state that receipt of a supplemental oath/declaration would overcome this rejection. The Office Action as to this

matter stated the following, clipped from an Adobe Acrobat pdf file of the prosecution file history:

Defective Oath/Declaration

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The specific changes/amendments to the claims must also be identified in the declaration, in addition to the errors in the original claims.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-139 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

By a paper stamped received at the PTO on April 14, 2004, applicants notified the PTO that inventor Larren Jones was deceased. Shortly thereafter, the original patent was surrendered.

E. THE CONTINUATION OF THE REQUIREMENT

Office Actions dated July 26, 2004, April 19, 2005, May 30, 2006, and December 21, 2006 made other rejections, and as to the oath/declaration, continued the requirement and statements clipped and included above. As a result of amendments filed between the Office Actions, the Office Action dated December 21, 2006 also indicated that the application was in condition for allowance, save for the matter of the oath/declaration.

F. THE FIRST SUPPLEMENTAL AND SECOND SUPPLEMENTAL DECLARATIONS

The applicants filed a first supplemental declaration on or about May 8, 2007. See Exhibit E attached. The applicants also filed a second supplemental declaration on or about July 31, 2007. See Exhibit F attached. The first supplemental declaration was on a PTO Form PTO/SB/51S. The second supplemental declaration was individually prepared. It also included a statement that the first supplemental declaration did not include, as follows:

To correct one error, the claim 1 limitation, "a second surface adapted to be positioned remote from the digging edge" (in regard to the boss), was removed from new claim 55.

Time passed, into late 2008.

G. THE OFFICE ACTION DATED OCTOBER 27, 2008

In the Office Action dated October 27, 2008, the requirement was continued that specific changes and amendments to the claims must be identified in detail in the declaration. The requirement also asserted, "It has to be recited as to what the error is with the patent, not what is being done to correct it." This was apparently a response to the statement in the second supplemental declaration that "To correct one error, [a] claim 1 limitation ... was removed from new claim 55." The requirement did not continue, however, to expressly state that receipt of a supplemental oath/declaration would overcome this rejection.

III. THE REQUIREMENTS OF THE PATENT STATUTE, CFR AND MPEP

The patent statute requires what MPEP 1401 states that it requires. A patent is to be reissued "whenever [it] is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, ... by reason of the patentee claiming more or less than he had a right to claim" As is stated in MPEP 1402, "the most common bases for filing a reissue application" include "(A) the claims are too narrow or too broad." 37 CFR 1.172 states the

requirement for a reissue oath, as in MPEP 1410.01. 37 CFR 1.175 states elements (A) – (D) of the required content of the reissue oath/declaration, as 37 CFR 1.175 is analyzed in MPEP 1414. As stated in MPEP 1414, “[r]eissue oaths or declarations must contain the following:

- (A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid -- ...
- (2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;
- (B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;
- (C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and
- (D) The information required by 37 CFR 1.63.”

MPEP 1414 discusses these elements at length. First, it states that applicants properly meet requirement (A) by including language such as: “Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming less than patentee had a right to claim in the patent.” MPEP 1414 also states as to requirement (B) that “The ‘at least one error’ which is relied upon to support the reissue application must be set forth in the oath/declaration.” MPEP 1414 continues that to meet this requirement, “[t]he corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration.” As to requirement (C), MPEP 1414 states that the requirement is met by including the following statement in an oath or declaration, “All errors in the present reissue application up to the time of signing of this oath/declaration, or errors which are being corrected

by a paper filed concurrently with this oath/declaration which correction of errors I/we have reviewed, arose without any deceptive intention on the part of the applicant," and further states that "[n]othing more is required." MPEP 1414 states that requirement (D) is met by statements that the applicants:

- “(A) have reviewed and understand the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath/declaration;
- “(B) believe the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and
- “(C) acknowledge the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.”

MPEP 1414.01 states what is required when additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration. As stated in MPEP 1414.01, in that situation, a supplemental oath/declaration is required. MPEP 1414.01 further states that an example of acceptable language is as follows: "Every error in the patent which was corrected in the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant." MPEP 1414.01 continues that "there is **no need to state an error** which is relied upon to support the reissue application if:

- (A) an error to support a reissue has been previously and properly stated in a reissue oath/declaration in the application; and
- (B) that error is still being corrected in the reissue application."

MPEP 1444 states the procedure for review of reissue oaths/declarations, and in doing so, restates the standards of MPEP 1414 without a separate, detailed discussion being provided in

MPEP 1444. MPEP 1453 states procedures for making amendments to reissue applications. It does not reference reissue oaths/declarations.

IV. THE REQUIREMENT THAT “THE SPECIFIC CHANGES/ AMENDMENTS TO THE CLAIMS MUST [] BE IDENTIFIED IN DETAIL IN THE DECLARATION IN ADDITION TO THE ERRORS IN THE ORIGINAL CLAIMS” IS NOT SUPPORTED IN THE PATENT STATUTE, CFR OR MPEP

As above, applicants are respectfully requesting reconsideration of the statement in the October 27, 2008 Office Action that the reissue declaration filed with this application is defective. The Office Action is stating a requirement that “the specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims.” This is understood to require that all specific changes and amendments to the claims must be identified in detail in the declaration. This is also understood to state that identification of an error in the original claims in the declaration is not enough.

A. THE APPLICANTS CANNOT LOCATE SUPPORT FOR THE REQUIREMENT IN THE PATENT STATUTE, CFR OR MPEP

Respectfully, this requirement for identification of specific changes/amendments to the claims in the declaration is not supported in the patent statute, CFR or MPEP. Applicants have diligently studied all three of the patent statute, CFR and MPEP and cannot locate support for the Office Action requirement.

1. THE APPLICANTS CANNOT LOCATE SUPPORT FOR THE REQUIREMENT IN THE PATENT STATUTE

First, applicants cannot locate support for the Office Action requirement in the patent statute. As above, the patent statute requires what MPEP 1401 states that it requires. A patent is to be reissued “whenever [it] is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, ... by reason of the patentee claiming more or less than he had a

right to claim ..." As stated in MPEP 1402, "the most common bases for filing a reissue application" include "(A) the claims are too narrow or too broad." The patent statute does not require anything as to an oath/declaration, let alone require that "the specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims."

2. THE APPLICANTS CANNOT LOCATE SUPPORT FOR THE REQUIREMENT IN THE CFR

Second, applicants cannot locate support for the Office Action requirement in the CFR. 37 CFR 1.172 states the requirements for a reissue oath, as referenced in MPEP 1410.01. 37 CFR 1.175 states the required content of the reissue oath/declaration, as in MPEP 1414. As in MPEP 1414, "reissue oaths or declarations must contain the following:

- (A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid -- ...
- (2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;
- (B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;
- (C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and
- (D) The information required by 37 CFR 1.63."

The CFR, as analyzed in MPEP 1414, as MPEP 1414 is quoted here, does not state a requirement that "the specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims."

3. THE APPLICANTS CANNOT LOCATE SUPPORT FOR THE REQUIREMENT IN THE MPEP

Third, applicants cannot locate support for the Office Action requirement in the MPEP. MPEP 1414 discusses the required elements (A) – (D) of oaths/declarations at length. First, it states that applicants properly meet requirement (A) above by including language such as this: “Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming less than patentee had a right to claim in the patent.” MPEP 1414 also states as to requirement (B) that “The ‘at least one error’ which is relied upon to support the reissue application must be set forth in the oath/declaration.” MPEP 1414 continues that to meet this requirement, “The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration.” As to requirement (C), MPEP 1414 states that the requirement is met by the following statement: “All errors in the present reissue application up to the time of signing of this oath/declaration, or errors which are being corrected by a paper filed concurrently with this oath/declaration which correction of errors I/we have reviewed, arose without any deceptive intention on the part of the applicant.’ Nothing more is required.” As to requirement (D), it is met in the typical three parts, by statements that the applicants:

“(A) have reviewed and understand the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath/declaration;

(B) believe the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(C) acknowledge the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.”

MPEP 1414, in all the discussion quoted and referenced here, does not require that “the specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims.” MPEP 1414 appears to be the single most relevant section of the MPEP on the content of oaths and declarations in reissue application. Applicants find it convincing that they cannot find any statement in MPEP 1414 that would indicate the existence of a requirement for identification of specific changes/amendments to the claims in detail in the declaration.

Further as to the MPEP, MPEP 1414.01 states what is required when additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration. As stated in MPEP 1414.01, in that situation, a supplement oath/declaration is required. MPEP 1414.01 further states that an example of acceptable language is as follows: “Every error in the patent which was corrected in the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

MPEP 1414.01 is especially notable insofar as it continues as to supplemental oaths/declaration, that “**there is no need to state an error** which is relied upon to support the reissue application if:

- (A) an error to support a reissue has been previously and properly stated in a reissue oath/declaration in the application; and
- (B) that error is still being corrected in the reissue application.”

This statement of the absence of need to even state an error in a supplemental oath/declaration would seem to be a strong statement by implication of the absence of need to state other aspects related to errors in the oaths/declarations, such as that “the specific

changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims.”

Further, this statement of the absence of a need to even state an error, *etc.*, is the situation of this application. Here, an error has been previously and properly stated in a reissue oath/declaration in the application. One, for example, was the error explained above, the error stated in the original declaration, of describing a lock as rigid in claim 1. MPEP 1414 states that a statement of an error is sufficient if it identifies “a single word, phrase, or expression in the specification or in an original claim, and how it renders the original claim wholly or partly inoperative or invalid.” The original declaration does this, stating that the “recitation that the lock has a rigid connection is more narrow than [the applicants] had a right to claim.” See Exhibit B at paragraph 5. Also, this error is still being corrected in the reissue application. It is being corrected by the inclusion of additional claim 55, which excludes the word “rigid” from its description of a lock, at line 9. Thus, applicants here do not even have a need for a supplemental oath/declaration that states an error, let alone have a need to identify specific changes/amendments to the claims. As well, requiring applicants to identify “specific changes/amendments” in the plural of “changes/amendments” contradicts MPEP 1414 in its statements that only a singular error needs to be specified, and that other errors *may* be specified, but need not be specified. Requiring the applicants to identify “specific changes/amendments to the claims … in detail in the declaration” also contradicts MPEP 1414 in its statements that corrective actions taken to overcome errors need not be specified.

Further, MPEP 1414.01, in all the discussion quoted and referenced here, does not require that “the specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims.”

Still further as to the MPEP, MPEP 1444 states the procedure for review of reissue oaths/declarations, and in doing so, restates the standards of MPEP 1414 without detailed discussion in MPEP 1444. MPEP 1453 states procedures for making amendments to reissue applications. It does not reference reissue oaths/declarations. None of MPEP 1444, MPEP 1453, or MPEP 1414, in all the discussion quoted and referenced here, requires that “the specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims.”

In sum, no part of the MPEP can be found that requires that “the specific changes/amendments to the claims must [] be identified in detail in the declaration in addition to the errors in the original claims.” There are also parts of the MPEP that contradict such a requirement.

In further sum, no part of the patent statute or CFR, in addition to the MPEP, can be found that makes this requirement either.

B. ROUTINE OFFICE PRACTICE, AS WELL, DOES NOT SUPPORT THE REQUIREMENT

In addition to the foregoing, routine PTO practice does not support the requirement. For example, the applicants have canvassed a group of recent reissue patents from RE 40,666 through RE 40,636, as will be presented here. These recently reissued patents were reissued without meeting a requirement as stated in the Office Action.

To present the information on routine Office practice, a table of information follows. The table includes four columns: 1. An identification of the reissue patent being referenced; 2. The answer to the question whether the reissue was filed as a result of the patentee claiming less than it had a right to claim, 3. the answer to the question whether the reissue declaration included an identification of all the specific changes/amendments to the claims in the declaration, and 4. if

the answer to number 3 is negative, the answer to the question whether an Office Action stated a requirement for such identification.

1. Reissue Patent Number Listed Below	2. Whether The Reissue Was For Claiming Less Than The Patentee Had A Right To Claim	3. Whether The Declaration Includes Identification of All The Specific Changes/Amendments To The Claims In The Declaration	4. Whether The Office Action Stated A Requirement for Identification of All The Specific Changes/Amendments To The Claims In The Declaration
RE 40,666	Yes	No	No
RE 40,665	Yes	Yes	No
RE 40,664	Yes	No	No
RE 40,663	Yes	Yes	
RE 40,662	Yes	No (Identifies one, not all.)	No.
RE 40,661	Yes	Yes	No
RE 40,660	Yes	No (Identifies one, not all.)	No
RE 40,659	No	NA	NA
RE 40,658	Yes	No	No
RE 40,657	Yes	Yes	No
RE 40,656	Yes	No	No
RE 40,655	No	NA	NA
RE 40,654	Yes	No	No
RE 40,653	Yes	No	No
RE 40,652	No	NA	NA
RE 40,651	No	NA	NA
RE 40,650	Yes	Yes	No
RE 40,649	No	NA	NA
RE 40,648	No	NA	NA
RE 40,647	Yes (and then changed in prosecution)	No	No
RE 40,646	Yes	No, not explicitly. States that a new claim corrects the error, and generally how. Adds many new claims.	No
RE 40,645	Yes	No	No
RE 40,644	Yes	No	No
RE 40,643	Yes	No (Identifies one, not all.)	No.

1. Reissue Patent Number Listed Below	2. Whether The Reissue Was For Claiming Less Than The Patentee Had A Right To Claim	3. Whether The Declaration Includes Identification of All The Specific Changes/Amendments To The Claims In The Declaration	4. Whether The Office Action Stated A Requirement for Identification of All The Specific Changes/Amendments To The Claims In The Declaration
RE 40,642	Yes	No (Identifies one, not all.)	No
RE 40,641	Yes	No	No
RE 40,640	No	NA	NA
RE 40,639	Yes	No	No
RE 40,638	No	NA	NA
RE 40,637	Yes	No	No
RE 40,636	Yes	Yes	No

Deleting the inapplicable reissue patents, i.e., those marked "NO," as to question 2, results in a second table, as follows:

1. Reissue Patent Number Listed Below	2. Whether The Reissue Was For Claiming Less Than The Patentee Had A Right To Claim	3. Whether The Declaration Includes Identification of All The Specific Changes/Amendments To The Claims In The Declaration	4. Whether The Office Action Stated A Requirement for Identification of All The Specific Changes/Amendments To The Claims In The Declaration
RE 40,666	Yes	No	No
RE 40,665	Yes	Yes	No
RE 40,664	Yes	No	No
RE 40,663	Yes	Yes	
RE 40,662	Yes	No (Identifies one, not all.)	No.
RE 40,661	Yes	Yes	No
RE 40,660	Yes	No (Identifies one, not all.)	No
RE 40,658	Yes	No	No
RE 40,657	Yes	Yes	No
RE 40,656	Yes	No	No
RE 40,654	Yes	No	No
RE 40,653	Yes	No	No
RE 40,650	Yes	Yes	No
RE 40,647	Yes (and then	No	No

1. Reissue Patent Number Listed Below	2. Whether The Reissue Was For Claiming Less Than The Patentee Had A Right To Claim	3. Whether The Declaration Includes Identification of All The Specific Changes/Amendments To The Claims In The Declaration	4. Whether The Office Action Stated A Requirement for Identification of All The Specific Changes/Amendments To The Claims In The Declaration
	changed in prosecution)		
RE 40,646	Yes	No, not explicitly. States that a new claim corrects the error, and generally how. Adds many new claims.	No
RE 40,645	Yes	No	No
RE 40,644	Yes	No	No
RE 40,643	Yes	No (Identifies one, not all.)	No.
RE 40,642	Yes	No (Identifies one, not all.)	No
RE 40,641	Yes	No	No
RE 40,639	Yes	No	No
RE 40,637	Yes	No	No
RE 40,636	Yes	Yes	No

Deleting the patents that are not applicable, approximately 23 patents are considered. Of those 23, 16 do not have a statement of all changes/amendments in the declaration and do not have a requirement for such. Another one, resulting in a total of 17 of 23, does not have an explicit statement. Seventeen of 23 is 73.9%. About seventy-four percent of reissue patents recently issuing did not state all changes/amendments to the claims in the declaration, and were not required to do so (Of course, the table was created based on applicants' lawyer's review of reissue patent files as available on the PTO website on the Internet, and applicants' lawyer's judgment as to what occurred, to the extent of reviewing the oaths/declarations and associated Office Actions. The examiner should not simply accept the applicants' lawyer's review and judgment, and should consider such matters for himself).

**C. THE APPLICANTS, CAN, HOWEVER, LOCATE A SOURCE FOR THE REQUIREMENT
IF THIS WERE A TIME BEFORE DECEMBER 1, 1997, NOT A TIME IN 2009**

Through research, applicants have determined that the CFR changed on December 1, 1997 as to the details required in reissue oaths/declarations. The CFR went from an “all errors/changes” approach to a “one error” approach. This can be seen in changes in the CFR, MPEP and Federal Circuit case law.

A comparison of the CFR from 1994 and 1997 illuminates the change. The old CFR is included here, and followed by the new CFR. As can be seen in the old CFR, before 1997, when the patentee asserted that the patent was inoperative or invalid by reason of the patentee claiming more or less than he had a right to claim, the patentee had to file a statement under oath or declaration “distinctly specifying the excess or insufficiency in the claims.” As can be seen in the new CFR, beginning in 1997, when the patentee made the same assertion, the reissue oath or declaration only had to state “at least one error being relied upon as the basis for reissue.”

37 CFR 1.175. Reissue oath or declaration. (a) Applicants for reissue, in addition to complying with the requirements of § 1.63, must also file with their applications a statement under oath or declaration as follows:

- (1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.
- (2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.
- (3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.
- (4) [Reserved]
- (5) Particularly specifying the errors relied upon, and how they arose or occurred.
- (6) Stating that said errors arose "without any deceptive intention" on the part of the applicant.
- (7) Acknowledging a duty to disclose information applicant is aware of which is material to the examination of the application.

(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object.

37 C.F.R. 1.175 (1997). Reissue oath or declaration.

§ 1.175 Reissue oath or declaration.

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

The change in 1997 can also be seen in the MPEP, by comparing the Sixth Edition of the MPEP, Revision 3, dated July 1997, and the Seventh Edition, dated July 1998. It can also be seen reflected in the case law of the Federal Circuit Court of Appeals.

The Sixth Edition of the MPEP, Revision 3, dated July 1997, had a section 1444 that stated in part that an examiner had to assure that every change/amendment to the specification and claims was particularly and distinctly specified and supported in a reissue oath/declaration. This old requirement can be seen in the second paragraph of the MPEP Sixth Edition, Revision 3, July 1997, clipped and included below:

1444 Review of Reissue Oath or Declaration [R-2]

When examining the reissue application, the examiner will consider at each stage or point in the examination whether or not the reissue oath or declaration complies with each of the requirements of 37 CFR 1.175; see MPEP § 1414 to § 1414.05. For example, in all reissue applications, the reissue oath or declaration must comply with the requirements of 37 CFR 1.63; see MPEP § 1414, and MPEP § 602, 37 CFR 1.63(b)(1) and (2), especially. Similarly, for example, all reissue declarations must comply with * sections (a)(5) *>, < (a)(6)>, and (a)(7)< of 37 CFR 1.175; see MPEP § 1414.03 *>, < § 1414.04 ** >and < § 1414.05.

The examiner must check that each and every change in the specification or claims is supported in either the original or a supplemental oath or declaration. Every departure from the original patent represents an "error" in said original patent under 35 U.S.C. 251 and must be particularly and distinctly specified and supported in the original, or a supplemental, reissue oath or declaration under 37 CFR 1.175. Any changes in the specification or claims require an updated supplemental oath or declaration specifically directed and supporting said changes under 37 CFR 1.175. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479, 1480 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any such supplemental oath or declaration should be filed promptly, preferably at the time of or as soon as possible after the changes in the specification and claims are filed. If the examination reveals a lack of compliance with any of the appropriate requirements of 37 CFR 1.175, a rejection of all the claims should be made on the basis that the reissue oath or declaration is insufficient.

The next edition of the MPEP, the Seventh Edition, dated July 1998, however, changed.

The change can be seen in the portion of section 1444 from this Seventh Edition clipped and included below. There is no statement here that an examiner had to assure that every change/amendment to the specification and claims was particularly and distinctly specified and

supported in a reissue oath/declaration. Instead, as in the current MPEP, the section refers the examiner to MPEP section 1414.

1444 Review of Reissue Oath/Declaration

In accordance with 37 CFR 1.175, the following is required in the reissue oath/declaration:

- (A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—
 - (1) by reason of a defective specification or drawing, or
 - (2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;
- (B) A statement of at least one error which is relied upon to support the reissue application, i.e., which provides a basis for the reissue;
- (C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and
- (D) The information required by 37 CFR 1.63.

MPEP § 1414 contains a discussion of each of the above elements (i.e., requirements of a reissue oath/declaration). The examiner should carefully review the reissue oath/declaration in conjunction with that discussion, in order to ensure that each element is provided in the oath/declaration. If the examiner's review of the oath/declaration reveals a lack of compliance with any of the requirements of 37 CFR 1.175, a rejection of all the claims under 35 U.S.C. 251 should be made on the basis that the reissue oath/declaration is insufficient.

The change in the CFR in 1997 can also be seen reflected in the case law of the Federal Circuit Court of Appeals. A most notable case is *Shockley v. Arcan, Inc.*, 248 F.3d 1349 (Fed. Cir. 2001). There, the Federal Circuit explained:

Section 1.175 of title 37 of the Code of Federal Regulations governs the examination of reissue applications. Old Rule 1.175 required the patentee to declare in detail the nature and origin of each error. 37 C.F.R. § 1.175(a) (1994).

The new rule, effective December 1, 1997, requires the patentee to disclose only a single error for correction and to include only a general statement that the errors involved no deceptive intent. 37 C.F.R. § 1.175(a) (1997).

Shockley, 248 F.3d at 1358.

Thus, as indicated by the quoted part of the opinion, the Federal Circuit recognized that the CFR changed in 1997, from an “all changes/errors” approach as to reissue oaths/declarations, to a “single error” approach.

The Federal Circuit also resolved that even with reissue applications pending before 1997, the new rule applied to them. *See Shockley*, 248 F.3d at 1359 (“Because the application which led to ‘732 reissue patent [which was the application the Federal Circuit was considering] was pending when the new rule took effect, the new rule applies in this case.”). The reissue application here, while pending for ten years, was filed in 1999. As a result, the new rule, 37 C.F.R. § 1.175(a) (1997), with its “one error” approach to reissue oaths/declarations, has always governed this application. It has also always required a statement of only one error in the declaration in this application.

V. RESPECTFULLY, IN THE ABSENCE OF SUPPORT FOR THE REQUIREMENT THAT “THE SPECIFIC CHANGES/AMENDMENTS TO THE CLAIMS MUST [] BE IDENTIFIED IN DETAIL IN THE DECLARATION IN ADDITION TO THE ERRORS IN THE ORIGINAL CLAIMS,” THE REQUIREMENT SHOULD BE RECONSIDERED

Respectfully, because the requirement for identification of specific changes/amendments to the claims in the declaration is apparently not supported in the patent statute, CFR or MPEP, the requirement should be reconsidered, and then withdrawn. As demonstrated above, support for the requirement cannot be found in the patent statute, CFR or MPEP. It is apparently not supported in that there is not a statement in the patent statute, CFR or MPEP that justifies the requirement. It is also not supported in PTO practice (almost 75% to the contrary).

A. THE APPLICANTS' ORIGINAL AND FIRST AND SECOND SUPPLEMENTAL DECLARATIONS SHOULD BE ACCEPTED AS FULLY COMPLIANT WITH THE PATENT STATUTE, CFR AND MPEP

Applicants' original declaration and first and second supplemental declarations satisfy the patent statute, CFR and MPEP. They should be accepted as fully compliant with the statute, CFR and MPEP. Indeed, they are as satisfactory as the relevant declarations in the last thirty reissue patents the Office has reissued.

For example, the original declaration and either and both of the first and second supplemental declarations satisfy 37 CFR 1.175 (A) – (D) and both of MPEP 1414 and 1414.01. The original declaration has statements that satisfy the 37 CFR 1.175 requirements (A) – (D). See Exhibit B attached. Satisfying requirement (A), the original declaration includes a statement that the applicant believes the original patent to be wholly or partly inoperative or invalid by reason of the patentee claiming more or less than the patentee had the right to claim in the patent:

5. We believe the '048 patent to be partially inoperative by reason of claiming less than we had a right to claim in the patent.

Satisfying requirement (B), the original declaration includes a statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue:

7. Claims 1 and 51 are each directed to a wear assembly which includes, inter alia, a rigid lock received in the opening in the wear member to hold the wear member to the boss. The recitation that the lock has a rigid construction is more narrow than we had a right to claim. The lock is placed within the opening to prevent removal of the wear member from the boss and is provided with an adjustment assembly to tighten the mounting of the wear member on the excavator, regardless of a specific rigid construction of the lock.

Satisfying requirement (C), the original declaration includes a statement that all errors which are being corrected in the reissue application up to the time of filing of the original oath/declaration arose without any deceptive intention on the part of the applicant:

11. All errors which are being corrected in this reissue application up to the time of filing of this declaration arose without any deceptive intention on our part.

Satisfying requirement (D), the original declaration includes the information required by 37 CFR 1.63, by statements that the applicants (A) have reviewed and understand the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath/declaration; (B) believe the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and (C) acknowledge the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56:

2. We believe that we are the original, first and joint inventors of the subject matter which is described and claimed in United States Patent No. 5,653,048 ("the '048 patent") entitled "Wear Assembly For A Digging Edge of An Excavator," granted August 5, 1997, for which invention we solicit a reissue patent.

3. We hereby state that we have reviewed and understand the contents of the above-identified specification, including the claims and all amendments included in this reissue application.

4. We acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §§ 1.56(a) and 1.175(a)(7).

The application also fits the rule of MPEP 1414.01 about when an error need not be stated in a supplemental declaration, such that there was no need to state an error in either the first or second supplemental declaration. As well, both the first and second supplemental declarations satisfy the language example of MPEP 1414.01 about stating that errors arose without deceptive intention. See Exhibits E and F. They include these statements:

I/We hereby declare that:

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of the applicant.

I/We hereby declare that:

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of the applicant.

To the extent that the second supplemental declaration includes a statement of what was done to correct an error, that “corrective action statement” does not disqualify the declaration from being a proper declaration – MPEP 1414 states that reciting the corrective action that was taken to overcome errors is acceptable, even though such as “corrective action statement” is not required. Finally, there is no issue as to whether the declarations leave open any “uncovered,” “later” errors. They do not leave any later errors unaddressed, as they were both filed in 2007, well after the last amendments to the application were made, in 2006.

VI. APPLICANTS' THIRD SUPPLEMENTAL DECLARATION

Applicants respectfully submit for the reasons set forth above that applicants' original declaration and first and second supplemental declarations, in combination, meet all of the requirements of the patent statute, CFR and MPEP. Nonetheless, in order to advance the prosecution, applicants submit herewith a third Supplemental Declaration, which details the specific changes/amendments to the claims that were made to overcome applicants' error in

claiming less than they had a right to claim. Reconsideration and withdrawal of the objection to the reissue declaration is requested in view of the remarks above and this further Supplemental Declaration.

Applicants' third Supplemental Declaration, attached hereto as Exhibit A, is executed by two of the three named co-inventors, Robert E. McClanahan and Hezekiah R. Holland. As applicants previously advised the Office in April 2004, the other named co-inventor, Larren F. Jones, is now deceased.

The patent statute, 35 U.S.C. §117, addresses the death or incapacity of an inventor and specifically provides that the legal representative of a deceased inventor may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. *Id.* 37 C.F.R. §1.42 thus provides, in case of the death of an inventor, that the legal representative, *i.e.*, the executor, administrator of the deceased inventor's estate, may make the necessary oath or declaration.

Alternatively, if there is no will, or if the will did not appoint an executor and the estate was under the sum required by state law for the appointment of an administrator, the heirs of the inventor may make the necessary oath or declaration:

.... Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and the estate was under the sum required by state law for the appointment of an administrator.

MPEP 409.01(a).

Further, in accordance with 37 CFR §1.47 and MPEP 409.03(c), if the legal representative of a deceased inventor (*i.e.*, the executor, administrator of the deceased inventor's estate or all of the deceased inventor's heirs) cannot be found or reached after diligent effort, the

application may be made by the other co-inventors on their own behalf and on behalf of the deceased co-inventor.

Applicants have diligently attempted to locate the heirs of Larren Jones who would be entitled (in accordance with 35 U.S.C. §117, 37 CFR 1.42, and MPEP 409.01(a)) to make the oath or declaration as the legal representative of the deceased inventor. However, the heirs of deceased co-inventor Larren Jones cannot be found or reached in all of their persons despite applicants' diligent efforts. Therefore, in accordance with 37 CFR §1.47 and MPEP 409.03, a Third Supplemental Declaration is made by Robert E. McClanahan and Hezekiah R. Holland on their own behalf and on behalf of the deceased inventor, Larren F. Jones. A petition pursuant to 37 C.F.R. § 1.47(a) for acceptance of this Supplemental Declaration is being submitted concurrently herewith.

VII. CONCLUSION

For the foregoing reasons, applicants respectfully request reconsideration and prompt passage of this application to reissue. The Examiner is invited to contact the undersigned at the telephone number listed below if doing so would be helpful in resolving any outstanding issues.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: July 27, 2009

By: /Charles W. Shifley/
Charles W. Shifley
Registration No. 28,042
Direct Dial: (312) 463-5441

RESPONSE TO FINAL OFFICE ACTION DATED OCTOBER 27, 2009 AND
ACCOMPANYING REQUEST FOR CONTINUED EXAMINATION

EXHIBIT A

U.S. Patent Appln. No. 09/368,503

Atty. Docket No. 051291.81516

**RESPONSE TO FINAL OFFICE ACTION DATED OCTOBER 27, 2009 AND
ACCOMPANYING REQUEST FOR CONTINUED EXAMINATION**

EXHIBIT B

5

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE REISSUE APPLICATION OF

LARREN F. JONES ET AL.

ATTY DKT: 51291.81516

PATENT NO: 5,653,048
ISSUED: AUGUST 5, 1997

SERIAL NO: 08/554,158
FILED: NOVEMBER 6, 1995

FOR: WEAR ASSEMBLY FOR A DIGGING
EDGE OF AN EXCAVATOR



JOINT REISSUE APPLICATION DECLARATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

We, Larren F. Jones, Robert E. McClanahan, and Hezekiah R. Holland, hereby declare that:

1. Our residences, post office addresses and citizenships are stated below next to our names.

2. We believe that we are the original, first and joint inventors of the subject matter which is described and claimed in United States Patent No. 5,653,048 ("the '048 patent") entitled "Wear Assembly For A Digging Edge of An Excavator," granted August 5, 1997, for which invention we solicit a reissue patent.

3. We hereby state that we have reviewed and understand the contents of the above-identified specification, including the claims and all amendments included in this reissue application.

4. We acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §§ 1.56(a) and 1.175(a)(7).

5. We believe the '048 patent to be partially inoperative by reason of claiming less than we had a right to claim in the patent.

6. Claims 1, 34, and 51 recite a boss in a manner more narrow than we had a right to claim. The claim recites that a second surface with a T-shaped coupling structure is remote from the first surface, front and rear bearing faces extend between the two surfaces, and the first surface has a clamping section which wraps around the digging edge of the excavator. The novel mount for the wear member includes a rear structure which is fixed to the excavator, coupled to the wear member and bears against the lock, and a front structure which wraps around the digging edge, irrespective of the particular relationship of the various specified surfaces.

7. Claims 1 and 51 are each directed to a wear assembly which includes, inter alia, a rigid lock received in the opening in the wear member to hold the wear member to the boss. The recitation that the lock has a rigid construction is more narrow than we had a right to claim. The lock is placed within the opening to prevent removal of the wear member from the boss and is provided with an adjustment assembly to tighten the mounting of the wear member on the excavator, regardless of a specific rigid construction of the lock.

8. In addition, the adjustment of the lock, in one aspect of the invention, is attained by adjusting threaded parts of the lock, irrespective of whether the lock has a specific rigid construction.

9. Claim 40 recites a lock member in a manner more narrow

than we had a right to claim. The claim includes a block shaped body having a rigid construction with a front face, a rear face and a pair of side faces. The claim further recites a latch in one of the side faces and an adjustment assembly extending orthogonally to the front and rear faces. The novel lock is adapted to be received into an opening in the wear member to hold the wear member to the boss with an adjustment assembly which selectively tightens the wear member onto the excavator.

10. Claim 47 recites a method which is more narrow than we had a right to claim. This claim recites the use of the adjustment means in removing the wear member from the excavator, but not the use of the adjustment means in mounting the wear member to the excavator.

11. All errors which are being corrected in this reissue application up to the time of filing of this declaration arose without any deceptive intention on our part.

12. We hereby appoint, both jointly and severally, as our attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith the following attorneys who are all members of the Bar of the District of Columbia, their registration numbers being listed after their names: Steven P. Schad, Registration No. 32,550; Patricia E. Hong, Registration No. 34,373, William W. Beckett, Registration No. 18,262; Donald W. Banner, Registration No. 17,037; Edward F. McKie, Jr., Registration No. 17,335; Dale H. Hoscheit, Registration No.

19,090; Joseph M. Potenza, Registration No. 28,175; James A. Niegowski, Registration No. 28,331; Joseph M. Skerpon, Registration No. 29,864; Thomas L. Peterson, Registration No. 30,969; Nina L. Medlock, Registration No. 29,673; William J. Fisher, Registration No. 32,133; Thomas H. Jackson, Registration No. 29,808; and Sarah A. Kagan, Registration No. 32,141.

13. All correspondence and telephone communications should be addressed to Banner & Witcoff, Ltd., 1001 G Street, N.W., Eleventh Floor, Washington, D.C. 20001-4597, which is also the address and telephone number of each of the above listed attorneys.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

SEARCHED - SERIALIZED

Larren F. Jones
Larren F. Jones

Date: 11/15/99

Address: 20333 NW Arza Lane Dr. #157

Residence: Aloha OR 97006

Citizenship: US

Robert E. McClanahan
Robert E. McClanahan

Date: 15 NOV 99

Address: 5029 S.E. REEDWY ST.

Residence: PORTLAND, OR 97206

Citizenship: US

Hezekiah R. Holland

Date: _____

Address:

Residence:

Citizenship: US

5029 S.E. REEDWY ST.

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE REISSUE APPLICATION OF

LARREN F. JONES ET AL.

PATENT NO: 5,653,048
ISSUED: AUGUST 5, 1997

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FOR: WEAR ASSEMBLY FOR A DIGGING
EDGE OF AN EXCAVATOR



JOINT REISSUE APPLICATION DECLARATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

We, Larren F. Jones, Robert E. McClanahan, and Hezekiah R. Holland, hereby declare that:

1. Our residences, post office addresses and citizenships are stated below next to our names.

2. We believe that we are the original, first and joint inventors of the subject matter which is described and claimed in United States Patent No. 5,653,048 ("the '048 patent") entitled "Wear Assembly For A Digging Edge of An Excavator," granted August 5, 1997, for which invention we solicit a reissue patent.

3. We hereby state that we have reviewed and understand the contents of the above-identified specification, including the claims and all amendments included in this reissue application.

4. We acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §§ 1.56(a) and 1.175(a)(7).

5. We believe the '048 patent to be partially inoperative by reason of claiming less than we had a right to claim in the patent.

6. Claims 1, 34, and 51 recite a boss in a manner more narrow than we had a right to claim. The claim recites that a second surface with a T-shaped coupling structure is remote from the first surface, front and rear bearing faces extend between the two surfaces, and the first surface has a clamping section which wraps around the digging edge of the excavator. The novel mount for the wear member includes a rear structure which is fixed to the excavator, coupled to the wear member and bears against the lock, and a front structure which wraps around the digging edge, irrespective of the particular relationship of the various specified surfaces.

7. Claims 1 and 51 are each directed to a wear assembly which includes, inter alia, a rigid lock received in the opening in the wear member to hold the wear member to the boss. The recitation that the lock has a rigid construction is more narrow than we had a right to claim. The lock is placed within the opening to prevent removal of the wear member from the boss and is provided with an adjustment assembly to tighten the mounting of the wear member on the excavator, regardless of a specific rigid construction of the lock.

8. In addition, the adjustment of the lock, in one aspect of the invention, is attained by adjusting threaded parts of the lock, irrespective of whether the lock has a specific rigid construction.

9. Claim 40 recites a lock member in a manner more narrow

than we had a right to claim. The claim includes a block shaped body having a rigid construction with a front face, a rear face and a pair of side faces. The claim further recites a latch in one of the side faces and an adjustment assembly extending orthogonally to the front and rear faces. The novel lock is adapted to be received into an opening in the wear member to hold the wear member to the boss with an adjustment assembly which selectively tightens the wear member onto the excavator.

10. Claim 47 recites a method which is more narrow than we had a right to claim. This claim recites the use of the adjustment means in removing the wear member from the excavator, but not the use of the adjustment means in mounting the wear member to the excavator.

11. All errors which are being corrected in this reissue application up to the time of filing of this declaration arose without any deceptive intention on our part.

12. We hereby appoint, both jointly and severally, as our attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith the following attorneys who are all members of the Bar of the District of Columbia, their registration numbers being listed after their names: Steven P. Schad, Registration No. 32,550; Patricia E. Hong, Registration No. 34,373, William W. Beckett, Registration No. 18,262; Donald W. Banner, Registration No. 17,037; Edward F. McKie, Jr., Registration No. 17,335; Dale H. Hoscheit, Registration No.

19,090; Joseph M. Potenza, Registration No. 28,175; James A. Niegowski, Registration No. 28,331; Joseph M. Skerpon, Registration No. 29,864; Thomas L. Peterson, Registration No. 30,969; Nina L. Medlock, Registration No. 29,673; William J. Fisher, Registration No. 32,133; Thomas H. Jackson, Registration No. 29,808; and Sarah A. Kagan, Registration No. 32,141.

13. All correspondence and telephone communications should be addressed to Banner & Witcoff, Ltd., 1001 G Street, N.W., Eleventh Floor, Washington, D.C. 20001-4597, which is also the address and telephone number of each of the above listed attorneys.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Larren F. Jones Date: _____

Address:

Residence:

Citizenship: US

Robert E. McClanahan Date: _____

Address:

Residence:

Citizenship: US

Hezekiah R. Holland

Date:

Address: 10 Box 111250
Anchorage, AK 99571-1250
Residence: Anchorage, AK
Citizenship: US

**RESPONSE TO FINAL OFFICE ACTION DATED OCTOBER 27, 2009 AND
ACCOMPANYING REQUEST FOR CONTINUED EXAMINATION**

EXHIBIT C

SEP-06-2006 WED 01:31 PM

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P. 03

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Claims:

1. (Original) A wear assembly for attachment to a digging edge of an excavator, the digging edge having an inside face and an outside face, said wear assembly comprising:
a boss having a first surface adapted to be fixed to the digging edge, a second surface adapted to be positioned remote from the digging edge and having a T-shaped structure, and a bearing face extending between said first and second surfaces;
a wear member having at least one rearwardly extending leg and a forwardly projecting working end, said leg having a T-shaped structure releasably coupled to said T-shaped structure of said boss, said leg further including an opening extending therethrough; and

a rigid lock received into said opening, said lock having a first face adapted to oppose and engage said bearing face of said boss and a second face adapted to oppose and engage a wall of said opening whereby said lock secures said wear member to said boss, said lock further including an adjustment assembly selectively movable to vary the relative positions of said first and second faces to eliminate looseness which may exist in mounting said wear member to the digging edge.

2. (Original) A wear assembly in accordance with claim 1, in which said opening has a generally T-shaped configuration with a stem portion that extends longitudinally and opens in said rear end and a lateral cross portion which includes said wall to oppose said lock.

3. (Original) A wear assembly in accordance with claim 1, in which said lock includes a body and said adjustment assembly includes a threaded bore extending through said body and a threaded plug operatively received into said bore, wherein said plug includes the first adapted to engage said bearing face of said boss.

4. (Original) A wear assembly in accordance with claim 1, in which said lock includes a body and said adjustment assembly includes a bore extending substantially through said body and a piston

said leg and said rear end wall, and a lock receiving opening extending through said leg and in communication with said slot, said slot having an internal shoulder and being adapted to receive a complementary tongue of a boss to prevent relative movement therebetween in directions other than longitudinal, and said opening being open in said rear end wall including a lateral shoulder in said leg spaced from said rear end wall to define a bearing surface for a lock to secure the wear member to the boss.

55. (Previously Presented) A wear assembly for attachment to a digging edge of an excavator, the digging edge having an inside face and an outside face, said wear assembly comprising: a boss having a mounting surface adapted to be fixed to the digging edge, a T-shaped coupling structure, and a bearing face extending transverse to said mounting surface; a wear member having at least one rearwardly extending leg and a forwardly projecting working end, said leg having a T-shaped coupling structure releasably coupled to said T-shaped structure of said boss, and an opening extending therethrough; and a lock received into said opening to hold said wear member to said boss, said lock having a first face adapted to oppose said bearing face of said boss, a second face adapted to oppose a wall of said opening, and an adjustment assembly selectively movable to vary the relative positions of said first and second faces to thereby apply forces to the wear member and the boss that tend to move the wear member so as to tighten the mounting of the wear member on the boss.

56. (Previously Presented) A wear assembly in accordance with claim 55 in which said opening has a generally T-shaped configuration with a stem portion that extends longitudinally and opens in a rear end of the leg of the wear member, and a lateral cross portion which includes said wall to oppose the lock.

57. (Previously Presented) A wear assembly in accordance with claim 55 in which the

RESPONSE TO FINAL OFFICE ACTION DATED OCTOBER 27, 2009 AND
ACCOMPANYING REQUEST FOR CONTINUED EXAMINATION

EXHIBIT D



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,503	08/05/1999	LARREN F. JONES	51291.81516	5616
7590	11/17/2003			EXAMINER
BANNER & WITCOFF LTD 1001 G STREET NW ELEVENTH FLOOR WASHINGTON, DC 200014597			BATSON, VICTOR D	
			ART UNIT	PAPER NUMBER
			3671	

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/368,503	JONES ET AL.
	Examiner Victor Batson	Art Unit 3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-139 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-139 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.	6) <input type="checkbox"/> Other: _____

Copy of Patent

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Defective Oath/Declaration

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The specific changes/amendments to the claims must also be identified in the declaration, in addition to the errors in the original claims.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-139 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Non-compliance with Rule 1.173

Additionally, Rule 1.173 (c) which reads as follows has not been complied with.
"Status of claims and support for claim changes. Whenever there is an

amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims." Appropriate correction is required.

Furthermore, Rule 1.173 (a) (2) which reads as follows has not be complied with.
"Drawings . Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application." Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 119-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (5,088,214) in view of Jones et al. (4,433,496).

Jones '214 discloses a wear assembly having all of applicant's claimed structure including a boss 29, a wear member including a longitudinal slot, and a lock 38. Jones

'214 however lacks the lock including an adjustment assembly movable to tighten the mounting of the wear member on the lip.

Jones et al. '496 teaches that it is known in the art to use a lock including an adjustment assembly movable to tighten the fit of the lock and eliminate looseness in the wear assembly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the wear assembly of Jones (5,088,214) by using a lock with an adjustment assembly as taught by Jones et al. '496, to eliminate looseness in the wear assembly.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Batson whose telephone number is (703) 305-6356. The examiner can normally be reached on Monday through Friday (except Wednesday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on (703) 308-3870. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1115.

October 1, 2003


Victor Batson
Primary Examiner
Art Unit 3671

**RESPONSE TO FINAL OFFICE ACTION DATED OCTOBER 27, 2009 AND
ACCOMPANYING REQUEST FOR CONTINUED EXAMINATION**

EXHIBIT E

RESPONSE TO FINAL OFFICE ACTION DATED OCTOBER 27, 2009 AND
ACCOMPANYING REQUEST FOR CONTINUED EXAMINATION

EXHIBIT F